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EXAMINER

HENRY, RODNEY M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,791	Applicant(s) YOO, SUNG-SAM	
	Examiner RODNEY M. HENRY	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/16/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a non-final, first office action on the merits. Claims 1-20, as originally filed, are currently pending and have been considered below.

Claim Objections

2. Claim 2 is objected to because of the following informalities: Claim 2, at line 1 reads "within an each shop". It should read "within each shop". Appropriate correction is required.

3. **Claims 16 and 17** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. See MPEP § 608.01(n)(II and III).

Claim Rejections - 35 USC § 112

4. **Claims 1-7** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The preamble of claim 1 recites a method but the body include "means" language, which is proper for a structural (system/apparatus) claim. Since claims 8-15 already recite a system, claims 1-7 are interpreted as a method and should be rewritten using only proper method steps.

6. Regarding claim 2, 3, 4 the phrase "can" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

See MPEP § 2173.05(d). Appropriate correction is required.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1, 2, 5, 6, 8, 9, 13, 14, and 16 are rejected under 35 U.S.C. 102(a) as being anticipated by Maeda et al. (US 2002/0059105).

As per Claims 1, 8:

Maeda et al. discloses an electronic circulation method and system in order to circulate electronic units for sales promotion, or simply sales promotion points hereafter, comprising

(a) a sales promotion point issuance and consumption means that issues and consumes sales promotion points per each shop, manufacturer or group of them and consumes sales promotion points within said each shop, manufacturer or group of them based on pre-determined point issuance conditions and pre-determined point consumption conditions in response to the requesting operation by a user on a terminal, and that manages said pre-determined issuance conditions, said pre-determined consumption conditions, the point issuance history and the point consumption history (see FIG. 13 and the users affiliated online shops, and FIG. 14 for usage history and consumption), and

(b) a sales promotion point exchange transaction means that makes said sales promotion points circulate not only within said each shop, manufacturer or group of

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them but also widely outside said each shop, manufacturer or group of them, wherein said sales promotion point exchange transaction means (p) manages a standard value of a sales promotion point that is arbitrarily determined by said each shop, manufacturer or group of them and that is consumed within said each shop, manufacturer or group of them (see FIG. 3 and the points listed for the affiliates shown),

(q) manages an exchange rate between sales promotion points that are issued by and consumed within each shop, manufacturer or group of them and sales promotion points that are consumed outside said each shop, manufacturer or group of them wherein said exchange rate is arbitrarily determined by said each shop, manufacturer or group of them (see page 4, paragraph [0056], which discusses the arbitrary exchange rate between a user and his/her affiliate shops),

(r) and executes sales promotion exchange transaction by calculating the necessary point amount required for exchange to a commodity or a service that a user wants based on said standard value of a sales promotion point and on said exchange rate, in response to the user's request (see FIG. 10 via points for camera, clock, etc., and FIG 13 for the user requests).

As per Claims 2, 9:

Maeda et al. discloses exchange rate between sales promotion points that are issued by and consumed within each shop, manufacturer or group of them and sales promotion points that are consumed outside said each shop, manufacturer or group of them can be determined arbitrarily according to the shop or the manufacturer or the group of them that provides the commodity or the service, or according to the product or

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the service that are provided by the shop or the manufacturer or the group of them (see page 4, paragraph [0056], which discusses the exchange rate between a user and his/her affiliate shops).

As per Claims 5, 13:

Maeda et al. discloses data of said sales promotion point exchange transaction are fed back to the shop, the manufacturer or the group of them that issued said sales promotion points (see FIG. 3 and the points affiliation to the issuer websites).

As per Claims 6, 14:

Maeda et al. discloses requesting operation by a user on a terminal is an access operation to a home page on the Internet ordering a commodity or a prize (see FIG. 3 for website addresses, and FIG. 13 for the users' affiliated online shops).

As per Claim 16:

Maeda et al. discloses a memory media used in the electronic circulation method in order to circulate electronic units for sales promotion claimed in claim 1, manufacturer or group of them and that is consumed within said each shop, manufacturer or group of them, manages an exchange rate between sales promotion points that are issued by and consumed within an each shop, manufacturer or group of them and sales promotion points that are consumed outside said each shop, manufacturer or group of them wherein said exchange rate is arbitrarily determined by said each shop, manufacturer or group of them, and executes sales promotion exchange transaction by calculating the necessary point amount required for exchange to a commodity or a service that a user wants based on said standard value of a sales promotion point and

on said exchange rate, in response to the user's request (see FIG. 2 for the memory unit and its functions, and pages 2,3, paragraph [0036] for the software which enables exchanges, also see page 4, paragraph [0056], which discusses the arbitrary exchange rate between a user and his/her affiliate shops, and see FIG. 10 via points for commodity exchange (camera, clock, etc.), and FIG 13 for the user requests).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 4, 10-12, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (US 2002/0059105), in view of Tomita et al. (US 6,965,869).

As per Claims 3, 10:

Maeda et al. discloses exchange rate can be further flexibly determined according to a period (see page 1, paragraph [0011]).

Maeda et al does not disclose exchange rate can be further flexibly determined according to time, or a season, and according to the attributes of the user who is a member of the sales promotion point exchange transaction service

However, Tomita et al. discloses exchange rate can be further flexibly determined according to time, or a season, and according to the attributes of the user who is a member of the sales promotion point exchange transaction service (see FIGS.

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9 (A), (B)) which discusses specific days and over several months [allows for covering seasons, for example, Christmas (winter), summer, etc.], 9 (E) for time, and 9 (j) for customer rank [attributes]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add time, or a season, and according to the attributes of the user who is a member of the sales promotion point exchange transaction service to the system of Maeda et al. One would have been motivated to do this in order to provide customers with flexible options for gaining points.

As per Claim 4, 11:

Maeda et al. does not disclose exchange rate can be changed at any time from an information input and output terminal of said sales promotion point issuance and consumption means, and the changed exchange rate is reflected on the exchange transaction of said sales promotion points on a real time base.

However, Tomita et al. discloses exchange rate can be changed at any time from an information input and output terminal of said sales promotion point issuance and consumption means, and the changed exchange rate is reflected on the exchange transaction of said sales promotion points on a real time base (see FIGS. 9(A) to 9(J) which show examples of display screens used to set a point calculation rate with the rate manager 10 and manager terminal 11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add exchange rate which can be changed at any time from an information input and output terminal of said sales promotion point

issuance and consumption means, and the changed exchange rate is reflected on the exchange transaction of said sales promotion points on a real time base to the system of Maeda et al.. One would have been motivated to do this in order to the system with flexibility and ease of making updates to promote customer satisfaction and loyalty.

As per Claim 12:

Maeda et al. does not disclose a procedure that displays on a user terminal the estimated user's present point value based on the consumption conditions including said exchange rate, and that enables for a user referring to said user's present point value displayed on the user terminal to input manually, or to specify automatic calculation of, the point value required for exchanging to a commodity or a service.

However, Tomita et al. discloses a procedure that displays on a user terminal the estimated user's present point value based on the consumption conditions including said exchange rate, and that enables for a user referring to said user's present point value displayed on the user terminal to input manually, or to specify automatic calculation of, the point value required for exchanging to a commodity or a service (see FIGS. 26 (A), 27 (A) which shows screens for leisure items, commodity items and gift items and the automatic calculation of remaining points needed).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add point value required for exchanging to a commodity or a service to the system of Maeda et al. One would have been

motivated to do this in order to adequately inform customers of their status for getting the items they may desire.

As per Claim 17:

Maeda et al. discloses a memory media used in the electronic circulation method in order to circulate electronic units for sales promotion claimed in claim 1 (see FIG. 2 for the memory unit and its functions).

Maeda et al does not disclose the changed exchange rate is reflected on the exchange transaction of said sales promotion points on a real time base.

However, Tomita et al. discloses the changed exchange rate is reflected on the exchange transaction of said sales promotion points on a real time base (see FIGS. 9(A) to 9(J) which show examples of display screens used to set a point calculation rate with the rate manager 10 and manager terminal 11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add changed exchange rate being reflected on the exchange transaction of said sales promotion points on a real time base to the system of Maeda et al.. One would have been motivated to do this in order to the system with flexibility and ease of making updates to promote customer satisfaction and loyalty.

As per Claim 18:

Maeda et al. discloses a memory media claimed in Claim17 in which an executable program that enables to display on a user terminal the estimated user's present point value based on the consumption conditions including said exchange rate

(see FIG. 2 for the memory unit and its functions, and pages 2,3, paragraph [0036] for the software which enables exchanges).

Maeda et al does not disclose a user referring to said user's present point value displayed on the user terminal to input manually, or to specify automatic calculation of, the point value required for exchanging to a commodity or a service, is stored.

However, Tomita et al. discloses a user referring to said user's present point value displayed on the user terminal to input manually, or to specify automatic calculation of, the point value required for exchanging to a commodity or a service, is stored (see FIGS. 26 (A), 27 (A) which shows screens for leisure items, commodity items and gift items and the automatic calculation of remaining points needed).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add point value required for exchanging to a commodity or a service to the system of Maeda et al.. One would have been motivated to do this in order to adequately inform customers of their status for getting the items they may desire.

10. Claims 7, 15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (US 2002/0059105), in view of Bednarek (US 6,965,868).

As per Claims 7, 15:

Maeda et al. does not disclose sales promotion points include points that are given when an advertising home page or a banner is accessed by the user.

However, Bednarek et al. discloses sales promotion points include points that are given when an advertising home page or a banner is accessed by the user (see col 72, lines 58-64).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add sales promotion points being given when an advertising home page or a banner is accessed by the user to the system of Maeda et al.. One would have been motivated to do this in order to encourage users to visit the affiliated web sites.

As per Claims 19, 20:

Maeda et al. does not disclose sales promotion points can be used by a user as a participation ticket for a gaming home page or for a quiz home page provided on the Internet, and the prize for winning the game or for answering the quiz is paid back to the user in the form of said sales promotion points.

However, Bednarek et al. discloses sales promotion points can be used by a user as a participation ticket for a gaming home page or for a quiz home page provided on the Internet, and the prize for winning the game or for answering the quiz is paid back to the user in the form of said sales promotion points (see col 51, lines 26-33 which discusses credits [points] for a game, and col 53, lines 16-26 and FIG. 5 which discusses winning or loosing points getting credited to the points account, col 4, lines 4-7 discusses Internet sites and portals for gaming).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add gaming to the system of Maeda et al.. One

would have been motivated to do this in order to provide consumers with yet another vehicle for exercising their accumulated points.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

Chien, Emily et al. (US 20010054003) discloses a system and method for using loyalty points.

Postrel, Richard (US 20050021400) discloses a method and system for using multi-function cards for storing, managing and aggregating reward points.

Microsoft Computer Dictionary, Fifth Edition

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney M. Henry whose telephone number is 571-270-5102. The examiner can normally be reached on Tuesday through Friday from 7:30 am to 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMH

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622